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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,537	08/28/2003	Gregory G. Kuelbs	0638MH-40982-US	9033

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EXAMINER
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SAWHNEY, HARGOBIND S

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/650,537	Applicant(s) KUELBS, GREGORY G. 	
	Examiner Hargobind S. Sawhney	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 35-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/13/2006, 8/26/05</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 21-34 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 78-92 of copending Application No. 10/829,790. The conflicting claims are identical, they are not patentably distinct from each other as detailed below.

Instant Application No.	Copending Application	Discussion on differences, and additional References:
10,650,537	No. 10,829,790	
Claims 21-34	Claim 78-92	Claims 21-34 of the instant application are identical to the respective claims 78-92 of the copending application 10,829,790.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 21-34 of the instant application with the claimed features of claims 78-92 of the copending application 10,829,790

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 23, 24, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Valdner (US Patent No.; 5,349,975) hereinafter referred as Valdner.

Regarding claims 21, 23, 24, 29 and 30, Valdner discloses an umbrella apparatus 10 (Figure 1) comprising:

- a canopy portion 24 hingedly coupled to a pole portion 12 (Figure 1, column 2, line 9); a rechargeable electrical power system 44 – rechargeable battery - energizing the umbrella apparatus 10 (Figure 1, column 2, lines 37 and 38); a solar power system 38 disposed on the top of the pole portion 12 above the canopy 24 (Figure 1, column 2, lines 37-43); the solar power system 38 able to collect solar energy, and convert

- solar energy into electrical energy; the solar power system conductively coupled, with electrical wires (Figures 3 and 8 column 2, lines 37-43) to the rechargeable electrical power system 44; the electrical energy converted from the solar energy by the solar power system 38 being used for recharging the rechargeable electrical energy system 44 (Figure 1, column 2, lines 37-43); the solar system 38 being in fixed position relative to the pole portion 12, and does not move when the canopy portion operated between the opened and close position (Figures 5 and 6);
- the rechargeable energy system 44 disposed by the second housing below the canopy portion 12 (Figure 1);
  - a recharging system 56 receiving power from AC power outlet 54 for recharging the rechargeable energy system 44 (Figures 1 and 3, column 2, lines 37-43);
  - a rechargeable electrical power system 44 detachable from the umbrella apparatus 10, and attachable to a remote an AC docking station receiving power plug 58 (Figure 3, column 2, lines 37-43); and
  - a releasable plug 46 conductively coupling the rechargeable electrical power system 44 to the solar power system 38 (Figures 1 and 3, column 2, lines 34-43).

5. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Small (US Patent No.; 2,960,094) hereinafter referred as Small.

Regarding claims 21 and 22, Small discloses a beach umbrella apparatus (Figure 1) comprising:

- a canopy portion 11 hingedly coupled to a pole portion 10 (Figure 1, column 1, lines 47-50); a rechargeable electrical power system 35 – rechargeable battery - energizing the umbrella apparatus (Figure 1, column 2, lines 29-31); a solar power system 34 disposed on the top of the pole portion 10 above the canopy 11 (Figure 1, column 2, lines 29-31); the solar power system 34 able to collect solar energy, and convert solar energy into electrical energy; the solar power system 34 conductively coupled, with electrical wires (Figure 1, column 2, lines 29-37) to the rechargeable electrical power system 35; the electrical energy converted from the solar energy by the solar power system 35 being used for recharging the rechargeable electrical energy system 34 (Figure 1, column 2, lines 29-37); the solar system being in fixed position relative to the pole portion 10, and does not move when the canopy portion 11 operated between the opened and close position (Figure 1); and
- the rechargeable battery 34 positionable in the housing carrying the solar system 35 (Figure 1, column 2, lines 29-37).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US Patent No.; 2,960,094), hereinafter referred as Small, in view Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier.

Regarding claim 25, Small discloses a beach umbrella apparatus (Figure 1) comprising a canopy portion hingedly coupled to a pole portion; a rechargeable electrical power system energizing the umbrella apparatus; and a solar power system disposed on the top of the pole portion above the canopy. Although, umbrella disclosed by Small is a free- standing umbrella on the ground, Small does not disclose details of the base of the umbrella.

On the other hand, Perrier discloses a solar-powered umbrella apparatus 1 (Figure 1) comprising:

- a canopy portion 8 hingedly coupled to a pole portion 9 (Figure 1, English translation, page 2, line 1); and a pole portion 9 received in a removable, by removing the adjusting screw, base assembly 4- the combination of a sleeve integral with a base plate- (Figure 1).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Small by providing the base assembly as taught by Perrier for mounting the apparatus on the ground in stable position.

Regarding claims 26, Small in view of Perrier discloses the solar-powered umbrella apparatus further including a rechargeable charging system positioned within the base of the umbrella (Perrier, Figure 1, English translation, page 2, line 1).

8. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US Patent No.; 2,960,094) in view Perrier et al. (WO Patent No.; 93/00840) as applied to Claim 25 above, and further in view of Valdner (US Patent No.; 5,349,975).

Regarding claim 27 and 28, Small ('094) in view of Perrier discloses the solar-powered umbrella apparatus further including a rechargeable charging system positioned within the base of the umbrella. However, neither combined nor individual teaching of Perrier and Small teaches a rechargeable charging system receiving AC power from a power outlet.

On the other hand, Valdner ('975) discloses an umbrella apparatus 10 including a recharging system 56 receiving power from AC power outlet 54 for recharging the rechargeable energy system 44 (Figures 1 and 3, column 2, lines 37-43).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Small in view of Perrier by providing and positioning the AC-based charging system in addition to the solar power energy based charging system as taught by Valdner ('975) for the benefits redundant power supply imparting high operational reliability.

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9. Claims 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdner (US Patent No.; 5,349,975) in view of Walker et al. (US Patent No.; 5,911,493).

Regarding claim 31, Valdner ('975) discloses a solar energy based umbrella apparatus comprising a plurality of rib members supporting a canopy; and a battery-based power system rechargeable with solar power system.

However, Valdner ('975) does not teach the disclosed umbrella assembly including a lighting system carried by the rib member, and the lighting system being conductively coupled to the rechargeable lighting system.

On the other hand, Walker et al. ('493) discloses an umbrella apparatus (Figure 1) comprising: a plurality of rib assembly 16- the combination of a channel element 30 integral with a rib element 16 - supporting a canopy (not shown) and a lighting system 32 (Figure 1, column 2, lines 9 and 10).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Valdner ('975) by providing and positioning the lighting system as taught by Walker et al. ('493) for the benefits of high attention and decorative values of the device.

Regarding claim 32, Valdner ('975) in view of Walker et al. ('493) the solar energy based umbrella apparatus further comprising the lighting system 32 positioned within the rib assemblies 16 (Walker, Figure 1, column 2, lines 21-25).

Regarding claim 34, Valdner ('975) discloses a solar energy based umbrella apparatus meeting the limitations, except the following, in similar manner as that applied to claims 21 and 31 detailed above and in section 3 of this office action.

In addition, Valdner ('975) discloses a solar energy based umbrella apparatus further including: a hub 20 movable along the pole portion 12 (Figures 1 and 4, column 2, lines 9-13).

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valdner (US Patent No.; 5,349,975) in view of Mai (US Patent No.: 6,270,230 B1).

Regarding Claim 33, Valdner ('975) discloses a solar energy based umbrella apparatus comprising a plurality of rib members supporting a collapsible cover; and a battery-based power system rechargeable with solar power system.

However, Valdner ('975) does not teach the disclosed umbrella assembly including a lighting system carried by the collapsible cover, and the lighting system being conductively coupled to the rechargeable lighting system.

On the other hand, Mai (230 B1) discloses an Umbrella apparatus including a lighting system 83 carried by the collapsible cover 30 (Figure 1, column 2, lines 64- and 65).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Valdner ('975) by providing and positioning the lighting system as taught by Mai ('230 B1) for the benefits of high attention and decorative values of the device.

***Response to Amendment***

11. Applicant's arguments filed on January 17, 2006 with respect to the 35 U.S.C. 102(a) rejections of claims 21 and 23, and 35 U.S.C. 103(a) rejections of claims 22 and 24-34 have been fully considered but they are moot in view of the new ground(s) of rejections necessitated by the amendment.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS  
3/30/2006

  
ALI ALAVI  
PRIMARY EXAMINER